

Group I: Claims 1-13, 25-33, and 37, described as drawn to methods of transfecting a cell;

Group II: Claims 14-24, described as drawn to a method for immobilizing nucleic acid to a surface; and

Group III: Claims 34-37, described as drawn to a method of identifying a ligand of a receptor protein.

B. Between Species

The Examiner further required the Applicant to select a specifically named species of an additional complexing agent listed in the Markush group of claim 8, 21, or 32.

II. ELECTION

A. Between Groups of Claims

The Examiner required election of one of three groups of claims. The Applicant **traverses** this requirement.

1. Election

Nonetheless, for the purpose of providing a complete response to the Restriction Requirement, the Applicant elects Group I **with traverse** and without waiving the right to prosecute the non-elected claims in another application.

2. Traversal

The Applicant respectfully requests that the claims of Group I, Group II, and Group III be **joined** for examination.

The Applicant's traversal and requests are made on the ground that the Examiner has not met his burden of establishing that examining the claims of the three groups in a single application will create a serious burden on the PTO.

Restriction requires that the Examiner "must show by appropriate explanation" (1) a separate classification of the claimed inventions, (2) a separate status in the art when the

inventions are classifiable together, or (3) a different field of search (MPEP 808.02). However, this has not been done, as further discussed below.

a. Claims 14-24 and 34-37 Are Mis-Classified

For the Examiner to require restriction, he must show a separate classification, which shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search (MPEP 808.02(A)). However, the Examiner has classified Claims 14-24 under Class 436, entitled CHEMISTRY: ANALYTICAL AND IMMUNOLOGICAL TESTING, and subclass 518, entitled INVOLVING AN INSOLUBLE CARRIER FOR IMMOBILIZING **IMMUNOCHEMICALS** (emphasis added). However, the claims are directed to a method of immobilizing **nucleic acid**. Moreover, the claims are directed to a **method of immobilizing**, in contrast to the class designation of **testing**. Therefore, the Examiner has misclassified these claims. Because the claims are directed to **nucleic acid**, they appear more appropriately classified under Class 435, CHEMISTRY: MOLECULAR BIOLOGY AND MICROBIOLOGY.

Moreover, Claims 34-37 in Group III also appear to have been misclassified. The Examiner has classified these claims under Class 435, subclass 4, entitled "Measuring or testing process involving **enzymes** or **microorganisms**; composition or test strip therefore; processes of forming such composition or test strip," which is described as "Processes in which there is a direct or indirect qualitative or quantitative measurement or test of a material which contains an **enzyme** or **microorganism** or processes in which a material containing an enzyme or microorganism is used to perform a qualitative or quantitative measurement or test and compositions therefore and the processes of making such compositions" (emphases added). In contrast, the claims are directed to a method of identifying a ligand of a receptor, which method includes a **transfection complex** and a **cell**.

For these reasons, therefore, the Applicant requests that all the claims be examined together, or in the alternative, that the claims of Group II be examined with the claims of Group I.

b. A Separate Status Is Not Shown

To require restriction, the Examiner must show a separate status in the art for the different invention groups by providing an explanation which indicates a recognition of separate inventive effort by inventors (MPEP 808.02 (B)). However, the Examiner does not provide arguments showing **separate inventive efforts** by inventors. Indeed, Group I, Group II, and

Group III claims share the **common** element of a transfection complex comprising nucleic acid and first and second complexing agents. Thus, this requirement has not been satisfied. Accordingly, the Applicant respectfully requests joinder of Groups I, II, and III, or in the alternative, joinder of Groups I and II.

c. A Different Field of Search Is Not Demonstrated

A third basis for insisting upon restriction is a showing of a different field of search for the different groups of inventions. This requires the Examiner to show that "it is **necessary** to search for one of the distinct subjects in places **where no pertinent art to the other subject exists**. The **indicated different field of search** must in fact be pertinent to the type of subject matter covered by the claims." (emphases added, MPEP 808.02(c)). However, this showing is not provided.

Indeed, considerable overlap is likely in the search for the claims in Groups I, II and III, since the claims in each of the groups share the **common** element of a transfection complex comprising nucleic acid and first and second complexing agents. In other words, a prior art search for a transfection complex comprising nucleic acid and first and second complexing agents as recited in Group I claims is likely to reveal art which includes elements of the claims in each of Groups II and III.

d. Conclusion

Because the necessity for restriction is not established under any one of the three alternatives, it is respectfully requested that restriction between the claims of Groups I, II, and III not be required. In the alternative, it is respectfully requested that restriction between the claims of Groups I and II not be required

B. Between Species

The Examiner further required a specifically named species of an additional complexing agent listed in the Markush group of claim 8, 21, or 32 for the elected Group.

The Applicant elects the species "transcription molecules." The Applicant has requested that all Claims be examined together, or in the alternative, that Claims of Groups I and II (Claims 1-33 and 37) be examined together. Because the Applicant has elected Group I (**with traverse**), this election applies to Claims 8 and 32 in Group I. If all the claims are examined together, or if

in the alternative Claims 1-33 and 37 are examined together, then this election applies to Claims 8, 21 and 32.

The Applicant notes that, in accordance with the Office Action (page 5) and applicable law, upon the allowance of a generic claim, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claims as provided by 37 CFR 1.141.

CONCLUSION

The Applicant **traverses** the Examiner's requirement for election of one of the Groups of claims as initially designated, and respectfully request that all the claims, or in the alternative that Claims 1-33 and 37 (Groups I and II), be examined in this application, without waiving the right to prosecute the non-elected claims in another application. Should the Examiner disagree, the Applicant elects, **with traverse**, Group I, without waiving the right to prosecute the non-elected claims in another application.

The Applicant also elects the species "transcription molecules." Because the Applicant has elected Group I (**with traverse**), this election applies to Claims 8 and 32 in Group I. If all the claims are examined together, or if in the alternative the claims of Groups I and II (Claims 1-33 and 37) are examined together, then this election applies to Claims 8, 21 and 32.

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call Dr. Jaen Andrews collect at (618) 218-6900.

Dated: 1/17/03

Jaen E Andrews

Jaen Andrews
Registration No. 35,051

MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(608) 218-6900